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19 UNITED STATES DISTRICT COURT
20
21 NORTHERN DISTRICT OF CALIFORNIA

22 IMPINJ, INC.,

Case No. 4:19-cv-03161-YGR

23 Plaintiff,

24 v.
25
PLAINTIFF IMPINJ, INC.’S OPPOSITION
26 **TO NXP USA, INC.’S RETRIAL MOTIONS**
27 **IN LIMINE NUMBERS 1-5**

28 NXP USA, INC.,

Defendant.

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1 **I. OPPOSITION TO MOTION IN LIMINE NO. 1: IMPINJ SHOULD BE
2 ALLOWED TO INTRODUCE EVIDENCE OF “COPYING” INCLUDING
3 PRODUCT “TEARDOWNS”**

4 NXP seeks to exclude any evidence that it copied the ideas underlying the ’302 invention.
5 NXP also seeks to introduce, however, evidence that it independently developed its infringing pads
6 and, possibly, that such development was based on the tags it used for a different product—called
7 HITAG—that is very different from the products at issue. The motion should be denied, or, at the
8 least, to the extent it is granted, NXP should at least be precluded from introducing its HITAG
9 product and any evidence of independent development.¹

10 First, there is substantial evidence that NXP copied the innovations claimed in the
11 ’302 Patent. There was essentially undisputed testimony that customers liked the patented antenna
12 pads incorporated in Impinj’s Monza R6 integrated circuit (“IC”) and, in the Court’s words,
13 “clamored” for their inclusion in NXP’s next generation UCODE 8 product. Dkt. No. 472 (“Impinj
14 has shown a connection between the harm and the infringement where, in this basically two-player
15 market, customers have clamored for the large pads of the ’302 patent.”). More specifically,
16 because NXP was losing market share to the Monza R6, it developed a plan to “target” Impinj’s
17 Monza R6 IC. Zach Dep. at 78:11–17, May 13, 2022 (played at July 7, 2023, Trial Tr. at 493:3);
18 *id.* at 51:20–52:10 (played at July 7, 2023, Trial Tr. at 493:3) (admitting large pads were
19 incorporated based on customer interviews); Trial Exs. 157, 229 (Dkt. No. 499-4) at 19 (customers
20 wanting the large pads introduced by Impinj), 1327. As part of that plan, NXP paid tens of
21 thousands of dollars to purchase a teardown of the Monza R6 and asked its customers what features
22 they wanted in NXP’s next-generation product. Amtmann Dep. at 30:19–31:23, Apr. 5, 2022
23 (played July 7, 2023, Trial Tr. 491:11 to 492:25). NXP’s witnesses admitted that they adopted the
24 Monza R6 patented pad design at the request of and for the convenience of customers. *See, e.g.*,
25 July 11, 2023, Trial Tr. (Zenz) at 914:20–916:6 (“And by that, our — basically, it’s for the customer

26 ¹ There is no evidence that NXP used the HITAG pads on its infringing products. *See, e.g.*, July 12,
27 2023, Trial Tr. (Zenz) at 984:16–985:18, 988:9–989:3. The undisputed evidence is that the patented
28 and accused products are designed for “flip chip” attachment, which is different from the wire-
bonded attachment used for HITAG. The undisputed evidence is that NXP adopted large pads for
its infringing products because of the popularity of that feature on Impinj’s UHF RAIN products,
not because of the pads on a different non-UHF wire-bonded NXP product.

1 much more convenient if they have set up a production line for UHF production, yeah, and to use
 2 Impinj. ... They can use ... the same design and — from NXP and vice versa. Because then they
 3 save all the conversion time on the equipment to set up the equipment newly for a kind of different
 4 pad design.”) *see also* July 12, 2023, Trial Tr. (Zenz) at 974:10-976:17, 980:7-18. Indeed, NXP’s
 5 “Customer Requirements Document” for UCODE 8, which was the blueprint for the UCODE 8 IC,
 6 states as much. Trial Ex. 229 (Dkt. 499-4) at 229.19 (referring to positive customer feedback
 7 regarding for large copper pads first introduced by Impinj in the UHF market); *see also* Dkt. 499-
 8 3 (unredacted Impinj MIL) at 3:5-7. Based at least in part on this copying evidence, the jury found
 9 that NXP’s infringement of the ’302 Patent was willful.

10 Second, the law is clear that secondary considerations must be considered in connection
 11 with the obviousness inquiry, and that copying is one such consideration. “It is well-established
 12 that secondary considerations, such as commercial success, long-felt but unresolved need,
 13 unexpected results, copying, and the failure of others to develop the invention, must be considered
 14 as part of a court’s obviousness analysis.” *Pfizer Inc. v. Teva Pharm. USA, Inc.*, 460 F. Supp. 2d
 15 650, 652 (N.J. 2006) (*citing Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d
 16 1550, 1555, (Fed. Cir. 1995)); *cf. Leviton Mfg. Co. v. Pass & Seymour, Inc.*, No. 17-cv-46 (BMC),
 17 2021 WL 1648229, at *4 (Apr. 27, 2021, E.D.N.Y.) (granting new trial on validity because of
 18 improper exclusion of secondary considerations of non-obviousness); *Amgen Inc. v. Sandoz Inc.*,
 19 66 F.4th 952, 963 (Fed. Cir. 2023) (quoting *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 660 (Fed. Cir.
 20 2000)) (“Thus, there are a variety of objective indicia of nonobviousness that may inform the
 21 circumstances surrounding the origin of the subject matter sought to be patented including, but not
 22 limited to, ... copying”)

23 Third, when discussing copying generally, the courts have made clear that slavish copying
 24 is not required—copying the patented “ideas” is sufficient. *See Stryker Corp. v. Intermedics*
 25 *Orthopedics, Inc.*, 96 F.3d 1409, 1414 (Fed. Cir. 1996); *Liquid Dynamics Corp. v. Vaughan Co.,*
 26 449 F.3d 1209, 1225–26, (Fed. Cir. 2006), cert. denied, 127 S. Ct. 599 (2006); *Barry v.*
 27 *Medtronic, Inc.*, 250 F. Supp. 3d 107, 112, 114 (E.D. Tex. 2017) (granting enhanced damages after

1 finding copying where competing patent applications were similar, such as the placement of the
 2 devices' handles, and citing that "slavish copying" of a commercial embodiment is not required).

3 Fourth, the teardowns are relevant to NXP's state of mind in connection with copying.
 4 Courts have consistently allowed evidence of teardown as relevant to copying, and there is no
 5 reasonable basis for excluding them in this case. *See Liqwd, Inc. v. L'Oreal USA, Inc.*, 941 F.3d
 6 1133, 1137 (Fed. Cir. 2019) ("Evidence of copying may include internal documents, direct
 7 evidence such as photos of patented features or disassembly of products, or access and similarity
 8 to a patented product."); *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1285–86
 9 (Fed. Cir. 2000) (finding copying to be "compelling evidence of nonobviousness"); *Wonderland*
 10 *Switz. AG v. Evenflo Co., Inc.*, No. 1:20-cv-00727-JPM, 2022 WL 20591121, at *4 (D. Del. Dec.
 11 29, 2022) (denying motion to exclude teardowns because they are relevant to both willfulness and
 12 nonobviousness). NXP argues that the teardowns do not display the Impinj pads, which can be
 13 observed without a teardown. But the fact that NXP performed a teardown of Impinj products, and
 14 systematically analyzes Impinj's patented products, is at least relevant to whether NXP intended to
 15 copy the patented features. In other words, such evidence is relevant to NXP's state of mind, which
 16 is relevant to copying.

17 Fifth, NXP's argument that Impinj did not specifically refer to copying as a secondary
 18 consideration in response to a contention interrogatory regarding nonobviousness is not persuasive.
 19 NXP has the burden of proving invalidity, and of setting forth its contentions in detail. The Local
 20 Rules reflect this allocation of burdens by requiring Impinj to serve infringement contentions and
 21 NXP to serve invalidity contentions. Further, Impinj made clear both before and during the trial
 22 that NXP had copied Impinj's pad design and there is no plausible prejudice NXP can claim from
 23 Impinj not specifically setting forth that such copying was relevant to both willful infringement and
 24 nonobviousness. All evidence of copying was exclusively in NXP's possession so it cannot claim
 25 that it would have conducted other discovery if the interrogatory response were different.

26 Sixth, the cases relied upon by NXP do not warrant a different result. Some are easily
 27 distinguishable. *E.g., ICU. Med. Inc. v. RyMed Techs., Inc.*, 752 F. Supp. 2d. 486, 493 (D. Del.
 28 2010) (excluding evidence that defendant "many years ago copied other ICU products — not the

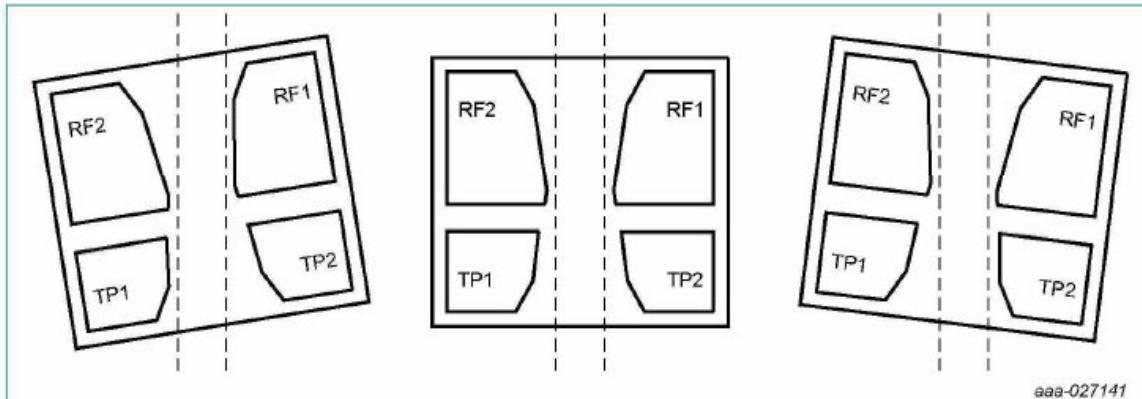
ones at issue here...."); *Olaf Sööt Design, LLC v. Daktronics, Inc.*, No. 15 Civ. 5024 (RWS), 2018 WL 6929176 (S.D.N.Y. Dec. 7, 2018) (granting motion for reconsideration excluding evidence that non-party copied the patent without explanation). Others undermine NXP's arguments. See *Loggerhead Tools, LLC v. Sears Holdings Corp.*, No. 12-cv-9033-RRP, 2017 WL 4161976 at *1 (N.D. Ill. Apr. 11, 2017) ("This ruling does not preclude admission of evidence of copying or non-copying."); *Medtronic, Inc. v. Teleflex Innovations S.a.r.l.*, 70 F.4th 1331, 1340-41 Fed. Cir. 2023 (holding that there was "more than sufficient circumstantial evidence to support the Board's finding of copying [to support non-obviousness]," and that copying can "be established through evidence of access to and substantial similarity with a patented product.") (emphasis in original).

For at least these reasons, the Court should deny NXP's motion and allow the jury to consider NXP's copying in connection with its obviousness analysis. To the extent the Court excludes evidence of copying, however, it should also exclude NXP from introducing evidence or arguing independent development based on the HITAG product or otherwise. As set forth in Impinj's motion *in limine* (Dkt. No. 500), such evidence at best is misleading because there is no evidence that the HITAG pads, which are not even directed to the flip chip technology at issue, were adapted for the infringing ICs. Further, as described above, there is more than sufficient evidence that NXP's decision to incorporate the pad design covered by the '302 Patent was not a result of "independent development"—it was based on customer "clamor" for Impinj's design.

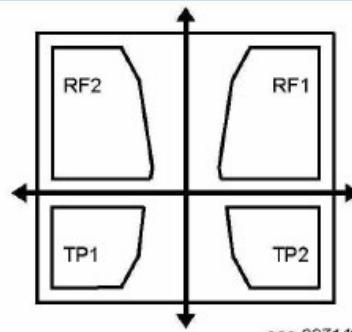
II. OPPOSITION TO MOTION IN LIMINE NO. 2: NXP'S INFRINGEMENT OF THE '302 PATENT IS RELEVANT TO VALIDITY

NXP seeks to prevent the jury from learning that it is infringing the '302 Patent, arguing that the finding of infringement is irrelevant to whether the '302 Patent is invalid. The motion should be denied because the finding of infringement is relevant to nonobviousness for at least two reasons. First, praise of a product that incorporates the patented innovation is strong evidence of nonobviousness. See, e.g., *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1334 (Fed. Cir. 2016) ("Evidence that the industry praised a claimed invention or a product which embodies the patent claims weighs against an assertion that the same claim would have been obvious. Industry participants, especially competitors, are not likely to praise an obvious advance over the known art.

1 Thus, if there is evidence of industry praise in the record, it weighs in favor of the nonobviousness
 2 of the claimed invention.”). In the instant case, NXP documents reflect that NXP believed its
 3 infringing pad design helped expel glue and enhanced antenna assembly speed. For example, the
 4 images below are from the official datasheet for the UCODE 8/8m and promote that the large pads
 5 with flared channels are more “rotation tolerant” and expel adhesive through the channel ends:



13 **Figure 9. Rotation tolerant pad design**



19 **Figure 10. Dual axis glue spacer**

21 *E.g.*, Trial Ex. 18 at 24.

22 Impinj should be allowed to introduce admissions about the efficacy and benefits of the
 23 inventions of the '302 Patent to the jury, but the admissions are only meaningful if the jury also
 24 understands that the NXP pad design in its commercially successful UCODE products practices
 25 the '302 Patent, as the Court determined as a matter of law. This is a sufficient basis to allow
 26 Impinj to introduce, or the Court to introduce through its instructions, that the NXP pad design has
 27 been found to infringe.

28

1 In addition, commercial success of a product embodying an invention is well-established as
 2 evidence of nonobviousness and, where the defendant's product is infringing, the success of that
 3 product is evidence of the commercial success of the invention. For this reason, courts have held
 4 that a jury should be informed that a defendant's product has been found to be infringing where the
 5 success of that product is relied on to show commercial success of the invention. *See Marine*
 6 *Polymer Techs., Inc. v. HemCon, Inc.*, No. 06-cv-100-JD, 2010 WL 1451171, at *1 (D.N.H. Apr.
 7 8, 2010): (evidence of infringement allowed during validity trial because “evidence of commercial
 8 success of [an infringing] product might be introduced in the context of invalidity based on
 9 obviousness. Therefore, the jury will be informed of the infringement determination.”);
 10 *Innovention Toys, LLC v. MGA Ent., Inc.*, No. 07-6510, 2012 WL 5384933, at *1-2 (E.D. La. Nov.
 11 1, 2012) (denying motion to exclude infringement determination during invalidity trial because
 12 “Plaintiff relies on the commercial success of MGA’s infringing Laser Battle game. Furthermore,
 13 in order for Plaintiff to submit that Laser Battle’s commercial success is an objective indicator of
 14 non-obviousness, Plaintiff must demonstrate that Laser Battle practices the ’242 patent, which
 15 constitutes infringement. The Court concludes the jury should be informed of Defendants’
 16 infringement...”).

17 The cases relied upon by NXP do not warrant a different outcome. There is no indication
 18 in any of the cases cited by NXP, for example, that the plaintiff was relying on defendant's
 19 admissions concerning its own product or the commercial success of that product. Further, at least
 20 in the *Novartis* decision, the plaintiff had to admit infringement to challenge the validity of a patent
 21 on a pharmaceutical compound. *Novartis Pharms. Corp. v. Teva Pharms. USA, Inc.*, No.
 22 CIV.A.05-CV-1887 DMC, 2009 WL 3754170, at *2 (D.N.J. Nov. 5, 2009). Impinj should be
 23 allowed to introduce the fact that NXP's products are infringing for these limited purposes.

24 While Impinj does not object to a limiting instruction of some sort, and will not dwell on
 25 NXP's infringement, it should be allowed to inform the jury that the NXP products practice the
 26 invention and explain the connection to the UCODE products' commercial success.

27
 28

1 **III. OPPOSITION TO MOTION IN LIMINE NO. 3: IMPINJ SHOULD BE
2 ALLOWED TO INTRODUCE WHO IT AND NXP ARE**

3 Impinj has never used the relative size, wealth, or number of employees of the parties to
4 suggest that NXP is somehow a “bad” company or that Impinj should prevail on any issue, and
5 agrees not to do so in the upcoming trial. Impinj should, however, be allowed to introduce the
6 parties to the jury, including their business, location, and size. This context is necessary for the
7 jury to even understand who the parties are and their dispute. None of the cases cited by NXP
8 prohibit the use of such information for this limited purpose. *See Mot.* (Dkt. No. 498) at 9 (citing
9 *HTC Corp. v. Tech. Props. Ltd.*, No. 5:08-cv-00882-PSG, 2013 WL 4782598, at *6 (N.D. Cal.
10 Sept. 6, 2013) (prohibiting “the use of a company’s overall size or revenue as a check to confirm
11 the reasonableness of a jury award”); *Roeder v. DIRECTV, Inc.*, No. C14-4091-LTS, 2017 WL
12 11458456, at *3 (N.D. Iowa May 31, 2017) (rejecting argument “that evidence related to the
13 comparative bargaining power between the parties is relevant to the economic realities test that the
14 jury must apply to determine whether plaintiffs were employees of DIRECTV” and therefore
15 excluding evidence plaintiffs intended to use for only that purpose); *Biscotti Inc. v. Microsoft Corp.*,
16 No. 2:13-CV-01015-JRG-RSP, 2017 WL 2537021, at *1 (E.D. Tex. May 30, 2017) (granting MIL
17 “as to Microsoft’s overall size, net worth, market capitalization, or stock value” without
18 explanation, but noting that this merely means that a “party must approach the bench before
19 introducing evidence or argument about [that] subject matter”); *Borders v. Arch Aluminum & Glass*
20 Co., No. 07-2188-JPO, 2008 WL 5427711, at *3 (D. Kan. Dec. 30, 2008) (precluding reference to
21 an individual defendant’s personal wealth in a racial discrimination case).

22 NXP’s assertion that Impinj should be precluded from introducing such context is based on
23 the meritless accusation that, in the first trial, “Impinj’s lawyers and witnesses repeatedly contrasted
24 Impinj’s size and implied value of Impinj with NXP’s” and will do so again “in an attempt to paint
25 NXP in a bad light.” Mot. at 8. In support of this allegation, NXP points to three instances in
26 which Impinj made (indisputably factual and nonprejudicial) statements about the size, location,
27 and/or business of the parties, and complains that such statements are “unfairly prejudicial to NXP.”
28 *Id.* First, NXP complains about counsel for Impinj’s reference to Impinj in opening as a “small

1 company” with “400 employees” that “do[es]n’t really have the time or money or desire to just pay
 2 lawyers” as part of the reason why Impinj is not a litigious company:

3 We spent two years trying to talk to them in — in correspondence,
 4 trying to avoid having to file suit. Impinj is a small company, 400
 5 people. They don’t really have the time or money or desire to just
 6 pay lawyers like me and my colleagues. They have better things to
 7 do. But they had to file suit because they couldn’t get it resolved.

8 July 5, 2023, Trial Tr. at 125:10–15; *see* Mot. at 8 (citing Tr. at 125:11–14).

9 NXP complains about a similar characterization made during closing to emphasize the
 10 importance of Impinj’s assertions in this case to its overall business, which is focused entirely on
 11 RAIN RFID:

12 As I said in opening, the reason we’re here is because Impinj is a
 13 relatively small company, 400 employees. And unlike NXP, as Mr.
 14 Amtmann said, this is a small part of their business. This is all of
 15 Impinj’s business. Impinj really has to protect its innovations.

16 Mot. at 8 (citing July 13, 2023, Trial Tr. at 1257:15–19).

17 These statements are focused on relevant aspects of who Impinj is that are based, in part,
 18 on the size and scope of its business—*independent* of the supposedly prejudicial size and scope of
 19 NXP’s business. Nothing in these statements (or any statements made by or on behalf of Impinj at
 20 trial) suggests that being a large and financially successful company somehow means NXP is “bad.”
 21 To the contrary, counsel for Impinj expressly acknowledged during opening, for example, that NXP
 22 has “a lot to be proud of” as a large and successful company, including that they have “lots of
 23 patents themselves on lots of things” in a variety of industries. July 5, 2023, Trial Tr. at 112:7–9.

24 The third and final instance NXP points to as an allegedly prejudicial comparison of the
 25 parties is a line of questioning during the direct examination of Impinj’s co-founder and CEO, Dr.
 26 Diorio, about Impinj’s significant contributions to the development of RAIN RFID. During this
 27 exchange, Dr. Diorio answered questions about the size and scope of both parties’ businesses,
 28 which helped put the magnitude of such contributions into perspective:

29 Q. ... What is the RAIN Alliance?

30 A. The RAIN Alliance is an organization that today has more than
 31 150 member companies. That is essentially an alliance of all the
 32 member companies to represent the industry to – to governments, to

1 get — further spectrum allocations to basically advance the overall
2 industry. Pretty much every industry has some sort of the consortium
3 of its member companies, and the RAIN Alliance is the consortium
for the RAIN industry.

4 Q. Who started is the RAIN Alliance?

5 A. I did.
6 ...
7 Q. And have you worked with NXP on things in this industry?
8 A. Yes, we have.
9 Q. What type of things?
10 A. We worked together in the early days to develop the — the
international standard, the standard for communicating information
over the air... NXP was — was a member of the working group that
was participating, and so I worked with NXP in developing that
standard as well as many other companies that were present.
11 Q. ...Does Impinj have patents relating to RAIN RFID?
12 A. Impinj has more than 300 patents relating to RAIN RFID.
13 Q. Do you have any reason to think any company in the world has
more?
14 A. I do not. I believe we have the most number of patents in our
industry.
15 Q. And how many employees does Impinj have?
16 A. Roughly 400 today.
17 Q. How many offices does Impinj have?
18 A. We have one primary office in Seattle. ...
19 Q. And how about NXP? What do you know about NXP?
20 A. NXP is a large multinational headquartered in the Netherlands
with, according to their filings, 33,000 employees, and they have a
number of different businesses.
21 Q. And so their only — their business isn't just RAIN RFID; is that
correct?
22 A. It is not. They have many businesses. They make all kinds of
semiconductor products. One of their businesses is RAIN RFID.
23
24 July 6, 2023, Trial Tr. at 236:12–238:16; *see* Mot. at 8 (citing July 6, 2023, Trial Tr. at 237:24–
25 238:7, 238:9–11).
26
27
28

1 In doing so, Dr. Diorio specifically acknowledged NXP's involvement in and developing
 2 the industry standard. *Id.* at 237:5–14. He did not, however, in any way suggest that NXP is “bad”
 3 because it is a large company with more employees, locations, and businesses. Indeed, Dr. Diorio
 4 admitted in the Washington trial that Impinj “aspire[s] to be a big company someday, too,” and has
 5 never feigned ignorance or embarrassment with respect to Impinj’s financial success:

6 Q. And Impinj is worth about \$3 billion right now; right?

7 A. That is correct. If you take all of our stock and mult — that’s
 8 issued to investors — and you multiply it by the stock price, the
 9 company is worth about \$3 billion.

10 Q. So we heard something from the opening and we’ve heard it
 11 suggested through this trial that it’s bad to be a big company.

12 Are you embarrassed by Impinj’s success?

13 A. I don’t — I am not embarrassed by Impinj’s success. I never said
 14 it was bad to be a big company. We aspire to be a big company
 15 someday, too. Right now, we’re a 400-person company.

16 Q. So hundreds of employees, billions in stock market capitalization,
 17 publicly trade; is that fair?

18 A. Those are all correct statements.

19 Q. And you hope to get bigger.

20 A. Indeed, I do.

21 Al-Salam Dec. Exh. A (June 13, 2023, W.D.WA trial transcript) at 82:3–18.

22 Dr. Diorio also agreed that “the size of a company [does not] determine whether or not its
 23 patent is valid” (or infringed). *Id.* at 83:24–84:4. This is hardly denigrating NXP for its size or
 24 purported wealth, or suggesting that Impinj should win on any issue due to its relative size or
 25 wealth.

26 Accordingly, there is no basis for NXP’s assertion that Impinj will reference the relative
 27 size, wealth, or number of employees of the parties “in an attempt to paint NXP in a bad light” to
 28 the jury, which, in any event, Impinj agrees not to do. Impinj should, however, be permitted
 reference such characteristics in an effort to introduce the parties to the jury.

1 **IV. OPPOSITION TO MOTION IN LIMINE NO. 4: IMPINJ SHOULD BE
2 ALLOWED TO CONNECT THE '302 PATENT WITH THE "ENDURO"
3 INNOVATIONS**

4 After reviewing NXP's motion in limine number 4, Impinj will not oppose the narrow relief
5 that is requested—specifically, Impinj will not refer to the '302 Patent as the "Enduro Patent."
6 Impinj should, however, be allowed to refer to its innovative large pads as part of its "Enduro"
7 innovations. There is no dispute that Impinj has marketed its large pad innovations as "Enduro.". NXP
8 is correct that the Enduro innovations go beyond the inventions claimed in the '302 Patent,
9 but that does not warrant excluding any references to Enduro. Further, the '302 Patent is directed
10 large contact pads with a specific channel shape. This is the fundamental aspect of the Enduro
11 innovations and is the specific aspect that NXP infringed. Indeed, the "Summary of Benefits" cited
12 by NXP for Enduro, including the larger connection area, the wider tolerance of assembly
13 parameters, connection resistance, etc., (Mot. at 12 citing Crowder Decl., Exh. H) are directly a
14 result of the '302 Patent inventions. NXP, of course, can point out that there are other aspects of
15 Enduro that are not specifically claimed in the '302 Patent.

16 **V. OPPOSITION TO MOTION IN LIMINE NO. 5: THE '302 PATENT IS
17 PRESUMED VALID BY LAW AND IMPINJ SHOULD BE ABLE TO SAY SO**

18 NXP's fifth motion in *limine* seeks to have the Court and jury ignore the presumption of
19 validity that attaches to all patents and does so based on a misleading description of the prosecution
20 history of the '302 Patent. Issued patents are presumed valid and NXP has the burden of
21 overcoming that presumption. This is black-letter statutory law:

22 *A patent shall be presumed valid. Each claim of a patent (whether in
23 independent, dependent, or multiple dependent form) shall be
24 presumed valid independently of the validity of other claims;
25 dependent or multiple dependent claims shall be presumed valid even
26 though dependent upon an invalid claim. The burden of establishing
27 invalidity of a patent or any claim thereof shall rest on the party
28 asserting such invalidity.*

29 35 U.S.C. § 282 (emphasis added); *Microsoft Corp v. I4I Ltd. P'ship*, 131 S. Ct. 2238, 2245 (2011)
30 ("By its express terms, § 282 establishes a presumption of patent validity, and it provides that a
31 challenger must overcome that presumption to prevail on an invalidity defense."). Indeed, the
32 presumption can be overcome only by clear and convincing evidence. *Id.* at 2246. The presumption

of validity applies with even more force where the Patent Office already considered the art, but “the presumption of validity is not weakened or destroyed where merely pertinent non-considered prior art is introduced, [although] the offering party is more likely to carry the burden of persuasion imposed by 35 U.S.C. § 282 when art more pertinent than that considered is introduced.” *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1566 (Fed.Cir.1983); *see also Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1375 (Fed. Cir. 1986) (“Notwithstanding that the introduction of prior art not before the examiner may facilitate the challenger’s meeting the burden of proof on invalidity, the presumption remains intact and on the challenger throughout the litigation, and the clear and convincing standard does not change.”).

NXP requests relief that directly contradicts the black latter law. Even worse NXP does so based on a misleading description of the file history. The claim language that was rejected by the examiner included a limitation of facilitating fluid flow from the center to the end of the channel (“the channel is shaped to facilitate a fluid flow from the center of the channel to the end of the channel”). (Dkt. No. 498-14 (Crowder Decl. Ex. L) at 5-6.) What secured the allowance of the claims was amending them to specify the shape of the channel with two ends being substantially wider than the center, not adding the fluid flow limitation. (Dkt. No. 498-14 at 11 (amending to add that the channel has a cross-section that is substantially the same at both ends and that is substantially wider than the cross-section at the center).) As part of the response, Impinj specifically highlighted the amendments to specify the channel shape having wider ends and a narrower center, rather than the fluid flow limitation. (Dkt. No. 498-14 at 15-16 (“Nowhere in his teachings, does Koep provide what is recited in amended Claim 1 at least ‘*a first transverse channel cross-section at the first end is substantially the same size as a second transverse cross-section at the second end and substantially larger than a third transverse channel cross-section at the center’.*”) (emphasis in original).) There simply is no evidence that the Examiner failed to consider the amended claim language or the validity issues or that the Examiner only allowed the claims because of a different interpretation of the fluid flow limitation than the one applied by the Court. Indeed, this Court expressly addressed the file history argument in its previous order addressing summary judgment and the parties’ motions to exclude, noting:

1 The Court rejects NXP's arguments that Impinj may not now argue
2 that the facilitation of fluid flow language is not a substantive
3 limitation on the ground that Impinj pointed out that prior art includes
4 such a limitation. (Dkt. No. 294 at 10.) Impinj detailed many
5 differences between the prior art and the claimed invention,
6 including specifics about how the shape of the channel facilitates
7 fluid flow (i.e., this is far from the only difference between the
8 claimed invention and the prior art, and it is arguably not a material
9 difference at all). ... the relevant wherein/whereby clause merely
10 states the intended purpose of the claim, not a substantive limitation.
11 Merely providing that as a distinction from prior art does not render
12 it substantive.

13 Dkt. No. 339 at 18 (excluding Dr. Subramanian from offering opinions that amounted to claim
14 construction to the jury); *see also id.* at 10-12 (granting summary judgment of infringement).
15 NXP in effect seeks to prevent the jury from being properly informed regarding the law and the
16 facts—that the claims were examined, were allowed, and that the claims are entitled to a rebuttable
17 presumption of validity. This would be error. NXP is, of course, able to introduce evidence and
18 argument attempting to demonstrate that the claims should not have been allowed and are invalid,
19 thus rebutting the presumption of validity. But the presumption of validity is required by law and
20 NXP's motion *in limine* number 5 should be denied in its entirety.

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1 Dated January 24, 2024
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4 By: /s/ Ramsey M. Al-Salam
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